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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,675	10/28/2003	Robert R. Mantell	7034/107	6826
757	7590	09/12/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			BOUCHELLE, LAURA A	
		ART UNIT	PAPER NUMBER	
			3763	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/696,675	MANTELL, ROBERT R.
	Examiner	Art Unit
	Laura A. Bouchelle	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 30-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/25/06, 11/12/04, 1/15/04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 17-29, 34-36 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups II and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/13/06.

2. Examiner made a telephone call to verify that cancelled claims 34, 35, included in the elected group, were cancelled accidentally. However, upon further consideration, the examiner regrets to inform applicant that the MPEP states that once claims are cancelled, they can not be reinstated. The claims can be added back into prosecution through an amendment after this non-final action if applicant so desires.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, 8, 11, 13, 16, 30, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Binard et al (US 3858572). Binard discloses an insufflation device comprising a gas delivery assembly having an output 70 coupled to a gas delivery path, a dual capacity tube 86 having a pair of tubes 88a, 88b attached to the second end of the tube, a valve 46 that operates

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pneumatically controlling the insufflation. See Fig. 1. The device of Binard is inherently disposable.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binard in view of Jaffe et al (US 2002/0059933). Claim 3 differs from Binard in calling for the valve to operate manually. Claim 4 calls for the valve to operate hydraulically. Claim 6 calls for the valve to operate electrically. Jaffe teaches an insufflation machine having a valve that operates manually, hydraulically, or electrically to provide enhanced reliability of the valve and the device (Page 2, paragraph 0016). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Binard to have a valve that operates manually, hydraulically or electrically as taught by Jaffe to provide enhanced reliability of the valve and the device.

7. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Binard in view of Jaffe as applied to claim 6 above, and further in view of Lucey (US 6042573). Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Binard in view of Lucey.

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Claim 7 differs from the teachings above in calling for the insufflator to comprise a controller and the valve to be operated by a signal from the controller. Claim 8 differs from Binard in calling for the valve to be a pressure relief valve. Lucey teaches a laparoscopic surgical device comprising a valve that is controlled in response to a signal to allow the flow of gas to the body to be controlled in response to the pressure of the insufflation gas (Col. 1, lines 18-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Binard in view of Jaffe to include a controller to operate the valve in response to a signal as taught by Lucey to allow the flow of gas to the body to be controlled in response to the pressure of the insufflation gas.

8. Claims 9, 10, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binard in view of Ott et al (US 6068609). Claims 9, 10, 31 differ from Binard in calling for the tubes to comprise filters. Ott teaches an apparatus for conditioning gas for use in a medical procedure such as endoscopy comprising tubes 160 having filters 110 to filter the insufflation gas to prevent inorganic particles such as metallic fillings or particles, rust, dust, and polymer particles from passing into the body cavity (Col. 1, lines 39-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Binard to include filters as taught by Ott to filter the insufflation gas to prevent inorganic particles such as metallic fillings or particles, rust, dust, and polymer particles from passing into the body cavity.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Binard. Claim 12 differs from Binard in calling for a second dual capacity tube. A mere duplication of parts has

no patentable significance unless a new and unexpected result is produced as a result of the duplication of parts. See MPEP 2144.04. Therefore, as applicant has not disclosed that the inclusion of a second dual capacity tube provides a new and unexpected result, there is no patentable significance over the prior art.

10. Claims 14, 15, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binard. Claims 14, 15, 33 call for the specific diameters of the tubes. Binard fails to specifically point out the dimensions of the tubes. Where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. See MPEP 2144.04. In the instant case, one of ordinary skill in the art would not expect Binard to perform differently than a device with the claimed relative dimensions, and therefore, the current invention is not patentably distinct over the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A. Bouchelle whose telephone number is 571-272-2125. The examiner can normally be reached on Monday-Friday 8-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 517-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura A Bouchelle
Examiner
Art Unit 3763

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